

REMARKS

Applicants thank the Examiner for total consideration given the present application. Claims 1-19 are currently pending of which claims 1 and 18 are independent. Applicants respectfully request reconsideration of the rejected claims in light of the remarks presented herein, and earnestly seek timely allowance of all pending claims.

35 U.S.C. § 103 REJECTION – Hussmann, Ritter

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Hussmann* (U.S. Pub. No. 2003/0218532 A1)(hereinafter “*Hussmann*”) in view of *Ritter* (CA 2,293,393) (hereinafter “*Ritter*”). Applicants respectfully traverse.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the “teaching, suggestion, motivation test” is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* **Rejections on obviousness grounds cannot be sustained by mere conclusory statements**; instead, **there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness**. *Id.*

Another requirement to establish *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited reference(s) to modify the reference(s) as proposed in the Office Action. *See M.P.E.P. 2143.01*. The cited reference must be considered in its entirety including disclosures that **teach away** from the claimed invention. *See M.P.E.P. 2141.02*. **If the cited reference(s) teach away from the claimed invention, then the combination is improper and the rejection must fail**.

A. First, it is again respectfully submitted that neither *Husmann* nor *Ritter*, alone or in combination, teaches or suggests all claim limitations.

For example, independent claims 1 and 18 recite, that the wireless communication device is “*connected to an antenna included in said subscriber identity module.*” (*Emphasis added.*)

The Examiner acknowledges that *Husmann* fails to teach or suggest that the wireless communication device is operatively controllable by said processing device and arranged to be operatively enabled or disabled, controlled by a signal provided by the mobile communication terminal via said I/O device. Thus, the Examiner imports *Ritter* to fulfill the above-noted deficiency of *Husmann*. Although Applicants do not necessarily agree with the Examiner that *Ritter* fulfills the above-acknowledged deficiency of *Husmann*, it is respectfully submitted that neither *Husmann* nor *Ritter*, alone or in combination, teaches or suggests a wireless communication device that is connected to an *antenna included in a subscriber identity module* as recited in claims 1 and 18.

As illustrated in Fig. 1, *Husmann* discloses a general concept of RFID (radio frequency identification) transponders. In the system described with reference to Fig 1, there is no indication whatsoever of a subscriber identity module, or a mobile communication terminal. Thus, Fig. 1 and its corresponding description are evidently not relevant.

In *Husmann's* embodiment illustrated in Fig. 2, a GSM mobile telephone 201 which includes a subscriber identity module (SIM) is shown. The SIM is accessible for the CPU of the telephone. (*See paragraph [0034].*) The mobile telephone also includes an interface 204 between the telephone's CPU and a memory unit 203 of an RFID transponder 202 which is *integrated in the telephone.* (*See paragraph [0035].*)

The embodiments illustrated in Figs. 3a-3c appear to show similar structural features as demonstrated above.

Husmann is distinguished from the claimed invention in that nowhere does *Husmann* teach or suggest that an antenna is included in the SIM. On the contrary, *Husmann's* RFID

transponder is clearly illustrated in Figs. 2 and 3a as being arranged separately from the SIM. (*Emphasis added.*)

Moreover, since paragraph [0035] reads "*an RFID transponder 202 integrated into the telephone*", and paragraph [0034] reads "*a detachable subscriber unit, is inserted into the phone*", it is evident that *Husmann* merely teaches arranging the transponder separately from the SIM.

Thus, it is respectfully submitted that *Husmann* fails to teach or suggest a wireless communication device that is connected to an antenna included in a subscriber identity module.

Ritter has not been, and indeed cannot be, relied upon to fulfill the above-noted deficiency of *Husmann*.

Ritter merely teaches that a communication controller and independent power storage can be integrated in the chip card, but there is no teaching about also including the antenna in the chip card. Instead, *Ritter* teaches that the antenna is integrated at the back of the housing of the mobile apparatus. (*See page 5, lines 16-17; page 7, lines 12-13.*) Thus, it is evident that *Ritter* does not teach an antenna included in the SIM.

Indeed, the Examiner states, "*Ritter* teaches the SIM card controls the activation of the wireless transponder via a signal through contact region (Page 8 Lines 8-21). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to have operatively controllable by said processing device and arranged to be operatively enabled or disabled, and controlled by a signal provided by the mobile communication terminal via said I/O device because it provides more flexibility in operating the system" (*see page 4, second full paragraph of the final Office Action.*) Applicants respectfully disagree for the following reasons.

Ritter teaches that a transceiver in a mobile apparatus may be controlled by a communication controller integrated in the chip card. For example, in Fig. 2, the transceiver 15 is illustrated as being part of the mobile apparatus 1. *Ritter* discloses in page 8, lines 10-12, as follows: "a communication controller 21 for the...transceiver 14/15 is integrated in the chip card 2 instead of in the mobile apparatus 1." Further, *Ritter* discloses in page 8, lines 12-14 as

follows: "The communication controller may... activate the transceiver 14/15 directly, ... via a contact region."

However, this is *contrary* to the claimed invention. *Ritter* does not disclose a transponder in the SIM controlled by a signal provided by the mobile communication terminal.

At least in view of the above, Applicants respectfully submit that the asserted combination of *Husmann* and *Ritter* (assuming these references may be combined, which Applicants do not admit) fails to establish *prima facie* obviousness of independent claims 1 and 18 or any claim depending therefrom.

B. Second, as mentioned earlier, if the cited reference(s) teach away from the claimed invention, then the combination is improper and the rejection must fail.

Notwithstanding Section A, above, it is respectfully submitted that *Husmann* and *Ritter* teach away from the possibility of having an interrogatable transponder in the SIM.

Husmann relates to a system where user-specific information is written to the memory of an RFID transponder included in the mobile device. For example, *Husmann* discloses as follows:

"...the invention more specifically relates to a portable electronic device comprising a transponder with a memory unit. The device is characterised by means for writing user-specific information into the transponder memory unit, so that the transponder, upon receiving an interrogating signal, generates a response signal comprising the user-specific information." (See paragraph [0009].)

"...the invention relates to a method for use in an interrogating apparatus for authenticating a user, who is carrying a portable, electronic device, comprising a transponder with a memory unit...said user-specific information being written, by means in the portable, electronic device, into a memory unit of the transponder..." (See paragraph [0017].) (Emphasis added.)

"a portable, electronic device, comprising a transponder with a memory unit said user-specific information being written, by means in the portable, electronic device, into a memory unit of the transponder..." (See paragraph [0021].) (Emphasis added.)

"...the telephone comprises an interface 204 between the CPU and the memory unit 203 of an RFID transponder 202 integrated into the telephone. This interface allows the telephone CPU to write user-specific information into the transponder memory unit 203 in the transponder IC." (See paragraph [0035].) (Emphasis added.)

"An RFID-transponder is then mounted in the PDA, and the PDA provides the transponder IC with user-specific information..." (See paragraph [0049].) (*Emphasis added.*)

The purpose of writing the user-specific information to the memory of an RFID transponder is that the user-specific information should not follow the device holding the RFID transponder if the device changes hands. This is mentioned in:

"In such a device the RFID-functionality is not statically tied to the device itself, but rather to the user of the device. This eliminates the problem associated with portable, electronic devices changing hands as described above." (See paragraph [0010].)

"A problem with using such devices in this manner is that they are sometimes stolen, lost, sold or given away. Any access right or user registration given to the associated RFID transponder identity is then inherited by the new possessor of the device. This implies a lack of security, since the device may be misused, and makes portable, electronic devices with RFID-transponders less credible." (See paragraph [0007].)

Because the RFID transponder has no user-specific information by default, one needs to retrieve that information from somewhere. According to *Hussmann*, the user-specific information is retrieved by the device (or more specifically, by a CPU of the device) from a detachable unit, which can either be a SIM for a mobile phone or a memory card for a PDA. This is disclosed in:

"Preferably, a portable, electronic device may comprise a detachable subscriber unit from which the user-specific information is retrieved." (See paragraph [0011].)

"The SIM-module contains user-specific data and is accessible for the CPU (CPU=Central Processing Unit) of the telephone." (See paragraph [0034].) (*Emphasis added.*)

"...the PDA provides the transponder IC with user-specific information, which may be stored in the PDA or in a memory card inserted into the PDA." (See paragraph [0049].) (*Emphasis added.*)

The examiner argues that *"Husmann does not exclude the teaching that the RFID transponder cannot be attached to a SIM card in a mobile device."* (See page 2, section 3 of the final Office Action.)

It is, however, respectively submitted that *Husmann* indeed does exclude that teaching. Although *Husmann* discloses in paragraph [0010] that "RFID-functionality is not statically tied to the device itself", *Husmann* does not disclose any portable, electronic device without an RFID transponder. Neither does *Husmann* disclose any motivation to place the RFID transponder elsewhere than in the device. Neither does *Husmann* specifically disclose a SIM with an RFID transponder. Neither is there any teaching in *Husmann* about the CPU reading the user-specific information from the SIM in order to write it to an RFID transponder in the SIM. Neither does *Husmann* disclose any motivation to place the CPU that does this work elsewhere than in the device itself. Neither does *Husmann* disclose placing that CPU specifically in the SIM. Neither does *Husmann* disclose the SIM reading the user-specific information and writing it to an RFID transponder in the SIM. *Husmann* is clearly device-centric, and therefore teaches away from the possibility where an RFID transponder is integrated in the SIM. There is therefore no support in *Husmann* for a "Subscriber identity module ... comprising ... a wireless communication device which is connected to an antenna included in said subscriber identity module."

The teachings of *Ritter* cannot fulfill the above-noted deficiency of *Husmann*. As mentioned earlier, *Ritter* teaches that a communication controller and independent power storage can be integrated in the chip card, but there is no teaching about also including the antenna in the chip card. Instead, *Ritter* teaches that the antenna is integrated at the back of the housing of the mobile apparatus. For example, *Ritter* discloses on page 5, lines 16-17 that the mobile apparatus has a housing 18. *Ritter* further discloses on page 7, lines 12-13 that the mobile apparatus in one modification contains another two-way interface, in this case an antenna 15 integrated at the back of the housing 18.

At least in view of the above, Applicants respectfully submit that the asserted combination of *Husmann* and *Ritter* (assuming these references may be combined, which

Applicants do not admit) fails to establish *prima facie* obviousness of independent claims 1 and 18 or any claim depending therefrom.

C. Teaching references *Duhs* and *Haugli* are irrelevant to the claimed invention.

The examiner argues that "*Duhs...teaches that the RFID transponder can be integrated with battery pack, master board, SIM card or microchip (Figures 3a-3c and Page 10)... Therefore, Hussmann teaches antenna is included in said subscriber identity module.*" Although *Duhs* does teach that there may be an antenna integrated in a SIM card, this is irrelevant because both *Hussmann* and *Ritter* clearly teach away from the possibility of including the antenna in the SIM.

At the outset, Applicants note that submitted herewith is a certified copy of the Norwegian priority document for the present invention (Application NO-20041347 was originally filed in English.) Accordingly, Applicants hereby perfect the priority date of March 31, 2004. Accordingly, *Haugli* is irrelevant because the priority date of *Haugli* is 2 Sep 2004, while the priority date of this patent application is 31 Mar 2004.

Therefore, for at least the reasons stated above in Sections A-C, Applicants respectfully request to withdraw the rejection of claims 1-19, based on *Hussmann* and *Ritter*.

CONCLUSION

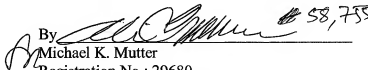
All rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Ali M. Imam Reg. No. 58,755 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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